

10/566535

Docket No. 4439-4039

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Kiyotaka Shiba and Kenichi Sano

Group Art Unit: tba

Serial No.: tba

Examiner: tba

Filed: January 30, 2006 (herewith)

For: PEPTIDES CAPABLE OF BINDING TO TITANIUM, SILVER, AND SILICONE

INFORMATION DISCLOSURE STATEMENT

Mail Stop PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Information Disclosure Statement is filed in accordance with 37 C.F.R. §§1.56, 1.97 and 1.98. The items listed on Form PTO-1449, a copy of which is enclosed, are made of record to assist the Patent and Trademark Office in its examination of this application. The Examiner is respectfully requested to fully consider the items and to independently ascertain their teaching.

1. ☒ For each of the following items listed on the enclosed copy of Form PTO-1449 that is not in the English language, an English language translation of that item or a portion thereof or a concise explanation of the relevance of that item is enclosed:
An English language abstract for JP 10-338700 is included.
An English language abstract for WO 01/28605 A1 is included.
2. ☐ For each of the following items listed on the enclosed copy of Form PTO-1449 that is not in the English language, a concise explanation of the relevance of that item is incorporated in the specification of the above-identified application.
3. ☐ Any copy of the items listed on the enclosed copy of Form PTO-1449 that is not enclosed with this Information Disclosure Statement was previously cited by or submitted to the Patent and Trademark Office in application Serial No. _____, filed _____.
4. ☒ No fee is due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with:
 - ☐ 37 C.F.R. §1.97(b)(1), within three months of the filing date of a national application other than a CPA; or
 - ☒ 37 C.F.R. §1.97(b)(2), within three months of the date of entry into the national stage as set forth in §1.491 in an international application; or

- ☐ 37 C.F.R. §1.97(b)(3), before the mailing date of a first Office action on the merits; or
- ☐ 37 C.F.R. §1.97(b)(4) before the mailing date of a first office action after the filing of an RCE under §1.114.
5. ☐ No fee is due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with 37 C.F.R. §1.97(c), after the period specified in paragraph 4 above but before the mailing date of a final action or a Notice of Allowance (where there has been no prior final action), and is accompanied by one of the certifications pursuant to 37 C.F.R. §1.97(e) set forth in paragraph 9 below.
6. ☐ A fee is due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with 37 C.F.R. §1.97(c), after the period specified in paragraph 4 above but before the mailing date of a final action or a notice of allowance (where there has been no prior final action):
- ☐ A check in the amount of \$180.00 is enclosed in payment of the fee.
- ☐ Charge the fee to Deposit Account No. 13-4500, Order No. _____. A
DUPLICATE COPY OF THIS SHEET IS ATTACHED.
7. ☐ A fee is due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with 37 C.F.R. §1.97(d), after the mailing date of a final action or a notice of allowance, whichever comes first, but before payment of the issue fee, and is accompanied by:
- a. one of the certifications pursuant to 37 C.F.R. §1.97(e) set forth in paragraph 9 below; and
- b. the fee due under 37 C.F.R. §1.17(p) which is paid as set forth in paragraph 11 below.
8. ☐ This Information Disclosure Statement is being filed in compliance with:
- a. ☐ 37 C.F.R. §1.313(b)(3) or §1.313(c)(1), after the issue fee has been paid and information cited in this Information Disclosure Statement may render at least one claim unpatentable and is accompanied by the attached Petition To Withdraw Application From Issue and fee pursuant to 37 C.F.R. §1.17(h);
- b. ☐ 37 C.F.R. §1.313(c)(2) or §1.313(c)(3), after the issue fee has been paid and information cited in this Information Disclosure Statement is to be considered in a Request for Continued Examination (RCE) or a Continuation application upon abandonment of the instant application and is accompanied by the attached Petition To Withdraw Application From Issue and fee pursuant to 37 C.F.R. §1.17(h).
- c. ☐ The fee due under 37 C.F.R. §1.17(h) is paid as set forth in paragraph 11 below.
9. ☐ I hereby certify that each item of information contained in this Information Disclosure Statement was first cited in a communication from a foreign patent

office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement.

☐ I hereby certify that no item of information in the Information Disclosure Statement filed herewith was cited in a communication from a foreign patent office in a counterpart foreign application or, to my knowledge after making reasonable inquiry, was known to any individual designated in §1.56(c) more than three months prior to the filing of this Information Disclosure Statement.

10. ☐ This document is accompanied by ☐ a Search Report ☐ Communication which was cited in a corresponding ☐ PCT or ☐ Foreign counterpart application

11. ☐ A check in the amount of \$ _____ is enclosed in payment of the fees due under 37 C.F.R. §§1.17(h) and 1.17(p).


☐ Charge the fees due under 37 C.F.R. §§1.17(h) and 1.17(p) to Deposit Account No. 13-4500, Order No. _____. A DUPLICATE COPY OF THIS SHEET IS ATTACHED.

☒ The Commissioner is hereby authorized to charge any additional fees which may be required for this Information Disclosure Statement, or credit any overpayment to Deposit Account No. 13-4500, Order No. 4439-4039. A DUPLICATE COPY OF THIS SHEET IS ATTACHED.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Dated: January 30, 2006

By: _____


Kenneth H. Sonnenfeld / Michael A. Willis
Registration No. 33,285 / Reg. No. 53,913

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| FORM PTO-1449A INFORMATION DISCLOSURE CITATION | Attorney Docket: 4439-4039 | Serial No. 80/566535 tba |
| | Applicant: Kiyotaka Shiba and Kenichi Sano | |
| | Filing Date: January 30, 2006 (herewith) | Group Art Unit: tba |

U.S. PATENT / PUBLICATION DOCUMENTS

| Examiner Initial | | Patent/Publication Number | Publication/Issue Date | Name | Filing Date |
|------------------|-----|---------------------------|------------------------|------|-------------|
| | 1. | | | | |
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FOREIGN PATENT DOCUMENTS

| Examiner Initial | | Patent Number | Publication Date | Country | Copy Filed | Translation |
|------------------|-----|-----------------|------------------|---------|---|--|
| | 15. | JP 10-338700 | Dec 12, 1998 | Japan | <input checked="" type="checkbox"/> Yes | <input type="checkbox"/> Yes <input type="checkbox"/> No <input checked="" type="checkbox"/> Abstract <input type="checkbox"/> N/A |
| | 16. | WO 03/029431 A2 | Apr 10, 2003 | WIPO | <input checked="" type="checkbox"/> Yes | <input type="checkbox"/> Yes <input type="checkbox"/> No <input type="checkbox"/> Abstract <input checked="" type="checkbox"/> N/A |
| | 17. | WO 01/28605 A1 | Apr 26, 2001 | WIPO | <input checked="" type="checkbox"/> Yes | <input type="checkbox"/> Yes <input type="checkbox"/> No <input checked="" type="checkbox"/> Abstract <input type="checkbox"/> N/A |
| | 18. | WO 02/060506 A1 | Aug 8, 2002 | WIPO | <input checked="" type="checkbox"/> Yes | <input type="checkbox"/> Yes <input type="checkbox"/> No <input type="checkbox"/> Abstract <input checked="" type="checkbox"/> N/A |
| | 19. | WO 03/078451 A2 | Sep 25, 2003 | WIPO | <input type="checkbox"/> Yes | <input type="checkbox"/> Yes <input type="checkbox"/> No <input type="checkbox"/> Abstract <input checked="" type="checkbox"/> N/A |
| | 20. | | | | <input type="checkbox"/> Yes | <input type="checkbox"/> Yes <input type="checkbox"/> No <input type="checkbox"/> Abstract <input type="checkbox"/> N/A |

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|---|-----------------|
| Examiner | Date Considered |
| EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP §609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant. | |

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| FORM PTO-1449B INFORMATION DISCLOSURE CITATION | Attorney Docket: 4439-4039 | Serial No.: tba |
| | Applicant: Kiyotaka Shiba and Kenichi Sano | |
| | Filing Date: January 30, 2006 (herewith) | Group Art Unit: tba |
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NON PATENT LITERATURE DOCUMENTS

| Examiner Initials* | Cite No. ¹ | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published. |
|--------------------|-----------------------|---|
| | 1. | Naik et al, "Biomimetic Synthesis and patterning of silver nanoparticles," Nature Materials, vol. 1, pages 169-172; November 2002. |
| | 2. | Whaley et al, "Selection of peptides with semiconductor binding specificity for directed nanocrystal assembly," Nature, vol. 408, pages 665-668, June 8, 2000. |
| | 3. | Sano et al, "A Hexapeptide Motif that Electrostatically Binds to the Surface of Titanium," J. Am. Chem. Soc., vol. 125, no. 47, pages 14234-14235, November 26, 2003, published on web October 30, 2003. |
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|--------------------|--|-----------------|--|
| Examiner Signature | | Date Considered | |
|--------------------|--|-----------------|--|

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. 1 Applicant's unique citation designation number (optional). 2 Applicant is to place a check mark here if English language Translation is attached. This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.